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**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/117,214 07/24/98 SERVANTE

A 292/30.35.37

WENDEROTH LIND & PONACK
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WASHINGTON DC 20006

IM62/0622

EXAMINER

PRATT, C

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 06/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/117,214

Applicant(s)

SERVANTE ET AL.

Examiner

Christopher C. Pratt

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 5/3/00.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☒ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 17) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

1. Applicant's amendments and accompanying remarks filed 5/3/00 have been entered and carefully considered. Applicant's amendment is found to overcome the claim objections as well as the 112 "broad range/narrow range" rejection of claim 15. Despite this advance, the amendments are not found to patently distinguish the claims over the prior art. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

2. Claim 4 objected to because of the following informalities: Claim 4 recites the term "atom." This term should be plural. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as set forth in the last action.

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Applicant has amended claims 1 and 12 to read “a reasonably open film surface for printing.” Applicant argues that this phrase would be understood by a person of ordinary skill in the art to mean a sufficient area of a film surface has been treated with a printable surface area, without offering any evidence to this fact. Examiner contends that the common meaning of the word “open” does not imply a treated surface even to a person of ordinary skill in the printing art. Furthermore, there is no definition of this term found in applicant’s specification. Also, the use of the word “reasonably” renders the scope of this claim limitation indefinite. Said rejection is maintained from the last office action.

Claim 6 is indefinite because it recites the phrase “consisting essentially of.” This phrase renders the claim indefinite because it contradicts claim 1 from which it depends. Claim 1 sets for the contents of a surface layer using consisting essentially of language. Claim 6 attempts to introduce a new essential element by introducing new elements into said surface layer.

Claim 9 is indefinite because claim 1 isn’t drawn to a process. Applicant could overcome this rejection by modifying the language of claim 9 to read; a process for the manufacture of the printable film of claim 1....”

Claim Rejections - 35 USC § 102

5. Claims 1-5 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Mehta et al (5219641).

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Mehta's patent is drawn to a printable film comprising a substrate and at least a surface layer (abstract). Said layer covering at least one surface of said substrate and consisting essentially of a water-dispersible polymer and an ethylenically unsaturated compound disposed in amounts anticipating applicant's amounts (claim 1 and example 1). Said surface layer does not contain a polymerization photoinitiator (col. 2, lines 40-44).

With respect to claims 2-3, Mehta discloses substrates anticipating applicant's claimed substrates (col. 2, lines 15-30).

With respect to claim 4, Mehta discloses an alkyl acrylate (example 1).

With respect to claim 5, Mehta discloses urethane acrylate (example 1).

With respect to claim 9, Mehta discloses coating said layer on to said substrate then drying the coating (col. 3, lines 26-37).

Claim Rejections - 35 USC § 103

6. Claims 6-8 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehta et al (5219641) in view of Kuburaki et al (5047286).

Mehta discloses all elements of applicant's claim 1 from which claims 6-11 depend, as set forth above. Mehta fails to disclose the use of applicant's crosslinking agent, a primer layer, and a pressure-sensitive adhesive.

Kuburaki's patent is drawn to a printable film having improved printability. Said film comprising a substrate and a surface layer consisting of a water dispersible polymer

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(abstract). Kuburaki teaches the use of applicant's crosslinking agent in an amount anticipating applicant's claimed amount (col. 4, lines 50-67). It would have been obvious to a person of ordinary skill in the art to utilize the crosslinking agent taught by Kuburaki in the polymer of Mehta motivated by the reasoned expectation of providing Mehta's surface layer with increased strength and chemical, heat, and electrical resistance.

Kuburaki also discloses using a primer layer and an adhesive layer (col. 3, line 63 and col. 5, line 24). It would have been obvious to a person of ordinary skill in the art to utilize the primer layer taught by Kuburaki motivated by the reasoned expectation of providing Mehta's surface layer with increased adhesion to said substrate. It would also have been obvious to a person of ordinary skill in the art to utilize the adhesive taught by Kuburaki motivated by the reasoned expectation of providing Mehta's printable film with adhesive properties in order to be used in commercial products including labels (col. 5, lines 25-33).

Kuburaki further discloses inking a printable film then curing said ink with radiation after said coating has been dried (col. 3, lines 53-55). It would have been obvious to a person of ordinary skill in the art to ink the printable film of Mehta as taught by Kuburaki motivated by the reasoned expectation of creating said film into a label suitable for commercial products.

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pratt whose telephone number is 703-305-6559. The examiner can normally be reached on Monday - Friday from 7 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-308-2351 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.

Christopher C. Pratt
June 18, 2000


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700